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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,553	05/15/2000	ANDREAS KYNAST	10191/1378	2755
26646	7590	03/23/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			TORRES, MARCOS L	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/554,553

Applicant(s)

KYNAST ET AL.

Examiner

Marcos L. Torres

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-27-06 has been entered.

Response to Arguments

2. Applicant's arguments filed 2-27-06 have been fully considered but they are not persuasive. As to applicant argument to Mankovitz reference, Levac teaches those limitations. Regarding the arguments that Levac only refers to different message formats, not to data processing capabilities of the device; Levac teaches an interface to adapt data to a particular format so the terminal device can process the data (see col. 1, line 61 - col. 2, line 2), therefore Levac teaches adapting data to the different data processing capabilities of the terminal devices. The current rejection stands.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., capabilities of processing speech data; whether the display is small or large) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (U.S. Patent US005949492A) in view of Levac (U.S. Patent US005872926A).

As to claims 11, 16 and 18, Mankovitz discloses a terminal device for a reception of data from an infrastructure, the terminal device having specific data processing capabilities for processing the data (see col. 7, lines 35-46), the infrastructure making a data service available in a format, the infrastructure including interfaces via which the data in the format is adapted to the data processing capabilities of the terminal device (see col. 11, lines 1-12; col. 9, lines 36-46), the terminal device comprising: means for transmitting a request signal to the infrastructure via which data is requested from the infrastructure and with which information concerning the data processing capabilities is transmitted via the terminal device to the infrastructure (see col. 8, lines 25-31).

Mankovitz do not specifically discloses adapting data to users that have different data processing capabilities. In an analogous art, Levac discloses adapting data to users that have different data processing capabilities (see col. 1, line 61 - col. 2, line 2), thereby reaching various type of user equipment. Since, it is desirable to reach as many users as possible. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Levac teaching to the Mankovitz terminal for the simple reason of compatibility and increased revenue with new users.

As to claim 13, Mankovitz discloses everything claimed as explained above in addition the terminal device, wherein the terminal device is a car radio with supplementary functions (see col. 45, lines 3-10).

As to claim 14, Mankovitz discloses everything claimed as explained above in addition the terminal device, wherein the information concerning the data processing

Art Unit: 2687

capabilities of the terminal device includes a terminal device identifier (see col. 3, lines 4-30).

As to claim 12, Mankovitz discloses everything claimed as explained above in addition the terminal device, further comprising means for exchanging data with the infrastructure via a telephone network (see col. 9, lines 57-61). Mankovitz do not specifically disclose that the telephone network is a digital mobile network. However, OFFICIAL NOTICE IS TAKEN that the use of digital transmission in telephone network is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use the Makovitz and Levac teachings for the simple reason of using the bandwidth more efficiently.

Regarding claims 8-10 and 17, they are the corresponding method claims of apparatus claims 11-12 and 18. Therefore, claims 8-10 and 17 are rejected for the same reason shown above.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Levac and Ellis (U.S. Patent 5,699,255).

As to claim 15, Mankovitz discloses a method for transmitting information between an infrastructure and data users, the infrastructure including a service provider, the data users including terminal devices in a motor vehicle, the data users having specific data processing capabilities, the method comprising the steps of: making a data service available in a standardized format, using the infrastructure; and via interfaces situated in the infrastructure (see col. 7, lines 35-46; col. 8, lines 25-31; col. 11, lines 1-12; col. 9, lines 36-46).

Mankovitz does not specifically disclose adapting data to the data processing capabilities of the data users or wherein the data includes geographic information. In an analogous art, Levac discloses adapting data to the data processing capabilities of the data users (see col. 1, line 61 - col. 2, line 2), thereby enhancing compatibility and user satisfaction. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Levac teachings to the Makovitz method for the simple purpose of reaching as many users as possible.

Mankovitz and Levac do not specifically disclose wherein the data includes geographic information. In an analogous art, Ellis discloses wherein the data includes geographic information (see col. 2, lines 5-25), thereby allowing sending geographic data to user and provide user location services. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine these teachings in order to add new subscribers and services, thereby increasing the profits.

Conclusion

Any response to this Office Action should be mailed to:

Art Unit: 2687

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Or faxed to:

571-273-8300

for formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/554,553

Page 8


Art Unit: 2687

Marcos L Torres

Examiner

Art Unit 2687


mlt


GEORGE ENG
SUPERVISORY PATENT EXAMINER